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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,114	01/14/2004	Saverio Carl Falco	BB1167USDIV2	3609

23906 7590 01/26/2005

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EXAMINER

WALICKA, MALGORZATA A

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,114

Applicant(s)

FALCO ET AL.

Examiner

Malgorzata A. Walicka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I₁₋₃. Claim 1-5, 10 and 11, drawn to a nucleic acid molecule encoding a sulfite reductase, and host cell comprising said molecule, classified in class 435, subclass 252.3.
- II₁₋₃. Claim 6, drawn to sulfite reductase polypeptide, classified in class 435, subclass 189.
- III₁₋₃. Claim 7, drawn to the method of altering the level of expressing of reductase in a host cell, classified in class 435, subclass 6.
- IV₁₋₃. Claim 8 and 9, drawn to obtaining a DNA molecule encoding agmatinase, classified in class 435, subclass 6.

The claims are directed to I2 inventions related to:

- 1) sulfite reductase from *Oryza sativa*, wherein said reductase is set forth by SEQ ID NO: 2,
- 2) sulfite reductase from *Glycine max*, wherein said reductase is set forth by SEQ ID NO: 4,
- 3) the sulfite reductase from *Triticum estivum*, wherein said reductase is set forth by SEQ ID NO: 6, and

comprising groups I-IV.

Inventions of Groups I-IV are distinct from each other for the following reasons.

Inventions I and II are directed to the enzyme and encoding DNA molecules which are different chemical entities having different chemical properties and biological

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functions. The searches for chemicals of Groups I and II, although overlapping, are different.

Inventions of Group I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case DNA molecule encoding sulfite reductase can be used for selection a homologous molecule by hybridization and not for altering the level of expression of sulfite assimilation protein in a host cell.

Inventions of Group I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case DNA molecule encoding sulfite reductase can be used altering the level of expression of sulfite assimilation protein in a host cell and not for selection a homologous DNA molecule by hybridization.

Inventions of Group II and III-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the enzyme sulfite reductase cannot

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be used in any of the methods of group III and IV, because these methods use another product, i.e., DNA encoding the enzyme.

In addition to election of any of invention from Groups I-IV, the Applicants are required to elect one of the claimed enzymes having sulfite reductase activity but originating from different plants and identified by amino acids sequences set for in SEQ ID NO: 2, 4, and 6, and having different DNA encoding sequences.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka whose telephone number is (571) 272-0944. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.


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Malgorzata A. Walicka, Ph.D.

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Patent Examiner



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